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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/658,740

09/10/2003

J. David Sandoval

25403

3391

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7590

04/11/2008

NATH & ASSOCIATES  
112 South West Street  
Alexandria, VA 22314

EXAMINER

ALMATRAHI, FARIS S

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

04/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/658,740	<b>Applicant(s)</b> SANDOVAL, J. DAVID	
	<b>Examiner</b> FARIS ALMATRAHI	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Status of the Application*

1. This action is in reply to applicant amendment filed December 19, 2007.
2. Claim 1 is amended.
3. Claims 1-18 are pending in this application.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-8, and 10-18** are rejected under 35 U.S.C. 102(e) as being anticipated by Richards et al. (US Publication No. 2003/0083920 A1).
6. Regarding claim 1, Richards discloses a method of administering cyclic use and movement of one or more reusable shipping structures comprising: a first party providing one or more empty reusable shipping structures to a second party at a first

value x; said second party placing materials on said one or more reusable shipping structures; and a third party purchasing said one or more reusable shipping structures from said second party at a second value y, wherein the shipping structures have materials thereon; (Abstract, Figure 1, Paragraph [0014], Paragraphs [0031] – [0032], Paragraphs [0034] – [0035]); wherein said second value y is less than said first value x (Paragraph [0032])

7. Regarding claim 2, Richards discloses a method further comprising the step of said second party valuing said one or more reusable shipping structures with materials thereon at a second value y (Figure 1, Paragraph [0025], Paragraphs [0031] – [0032]).

8. Regarding claim 3, Richards discloses a method further comprising the step of said third party removing the materials from said one or more reusable shipping structures (Paragraphs [0025] – [0026]).

9. Regarding claim 4, Richards discloses a method further comprising the step of said third party selling said one or more empty reusable shipping structures (Paragraph [0031]).

10. Regarding claims 5-6, Richards discloses a method wherein a fourth party delivers said one or more reusable shipping structures with materials thereon from said second party to said third party (Figure 1, Paragraph [0025]).

11. Regarding claim 7, Richards discloses a method wherein said second party charges its internal operations a usage fee which is the difference between the first value x and the second value y, for each reusable shipping structure put in use (Paragraph [0034]).

12. Regarding claim 8, Richards discloses a method wherein the first value x is about that of new or fully reconditioned reusable shipping structure (Paragraph [0034]).
13. Regarding claim 10, Richards discloses a method wherein said one or more reusable shipping structures are pallets (Figures 3-4).
14. Regarding claim 11, Richards discloses a method wherein said pallets are wooden pallets (Paragraph [0004]).
15. Regarding claim 12, Richards discloses a method wherein said first party is selected from the group consisting of a shipping structure supplier and a shipping structure recycler (Abstract, Paragraph [0026]).
16. Regarding claim 13, Richards discloses a method wherein said second party is a product manufacturer (Paragraphs [0024] – [0025]).
17. Regarding claim 14, Richards discloses a method wherein said third party is a product distributor (Paragraph [0025]).
18. Regarding claim 15, Richards discloses a method further comprising said first party reselling one or more empty reusable shipping structures to a second party (Abstract, Paragraphs [0030] – [0031]).
19. Regarding claims 16-18, Richards discloses a method wherein said third party sells said empty reusable shipping structure for an amount about equal to the second value y, greater than the second value y, or less than the second value y (Abstract, Paragraphs [0031] – [0032]).

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. **Claim 9** is rejected under 35 U.S.C 103(a) as being unpatentable over Richards et al. (US Publication No. 2003/0083920 A1) in view of (EFR Executive Committee and Pallet Subcommittee "Assessing Pallet Cost in Foodservice", Efficient Foodservice Response, pp. 1-22, 2000).

22. Regarding Claim 9, Richards fails to explicitly disclose a method wherein the second value y is about sixty percent of the first value x.

23. However, the value of y is regarded as design choice and can obviously be any percentage of the first value x. Furthermore, EFR discloses a method wherein the second value y is about sixty percent of the first value x (Pages 10-13).

24. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of EFR in the device of Richards reference to include a method wherein the second value y is about sixty percent of the first value x, for the advantage of providing design choice flexibility.

***Response to Arguments***

25. Applicant's arguments filed on December 19, 2007 have been fully considered but they are not persuasive

26. Regarding Applicants arguments that *there is no disclosure in the Richards et al. reference of a third party purchasing said one or more reusable shipping structures from said second party at a second value y, wherein the shipping structures have materials thereon and wherein the value y is less than the value x*. Examiner takes into account broadest interpretation of the recited limitation in the instant application. Richards discloses, in paragraphs [0031] - [0032], end recipients selling platforms to third parties which reads on a third party purchasing one or more reusable shipping structure from a second party at a value y. The instant application claims the cyclic use of reusable shipping structures disclosing a first, second and third party. Richards discloses a platform manufacturer, a shipper, a direct recipient, an end recipient, a coordinator and third party companies, and taking into account the broadest interpretation of the claim language in the instant application, the shipper, direct recipient or end recipient reads on "second party" taking into account that the role of the "first party" and "third party" can be implied by other participants disclosed by Richards.

27. Regarding Applicants arguments that *no value of the shipping structure is disclosed by Richards*. In response to applicant's argument, Richards discloses, in paragraph [0032], a sale amount which inherently reads on "value".

28. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the EFR reference was cited to show that it would have been obvious to include a second value to be a percentage of a previous value. Thus, it would be extremely advantageous to incorporate the teachings of EFR reference into the disclosure of Richards, for the same purpose stated in the previous action. Therefore, in view of the above evidence, the combination of Richards in view of the EFR reference still meet the scope of the limitations as currently claimed.

Furthermore, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, -- USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faris Almatrahi whose telephone number is (571)270-3326. The examiner can normally be reached on Monday to Friday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627

/Faris Almatrahi/  
Examiner, Art Unit 3627

FA